

Application of Christopher Tzann-en Szeto, Ser. No. 09/930,878, Filed August 15, 2001  
Reply to Final Office Action  
Attorney Docket No. 50269-0584

### REMARKS

Claims 1, 7-11 and 24-31 have been amended. Claim 14 has been cancelled, without prejudice. Claims 34-36 have been added. Claims 17-23 and 32-33 are withdrawn from consideration. Claims 1-13, 15, 16, and 24-31 and 33-36 are under examination.

### FINALITY OF REJECTION

The present Office Action was made final, asserting that Applicant's amendment in the response to the non-final Office Action mailed by the PTO on June 17, 2005 necessitated new grounds of rejection. Applicant requests that the finality of the Office Action be removed for the following reasons.

The Applicant traversed the rejection of the non-final rejection on the grounds that U.S. Patent No. 6,677,976 ("Parker") is not a valid reference under 35 U.S.C. 102(e). The examiner has removed the rejection based on Parker without stating any reasons therefore. Applicant asserts that the new grounds of rejection were necessitated due to Parker being removed as an invalid reference.

A final rejection is not appropriate when it is neither necessitated by Applicant's amendment nor necessitated by Applicant's information disclosure statement (IDS).

While the Applicant did amend claims in the response to the non-final office action, Applicant respectfully asserts that the claim amendments did not necessitate the new grounds of rejection.

Applicant did file an IDS. However, the new grounds of rejection do not appear to be based on material cited by Applicant in the IDS. Therefore, material in the IDS did not appear to necessitate the new grounds of rejection.

YHOOP001

16

Application of Christopher Tzann-en Szeto, Ser. No. 09/930,878, Filed August 15, 2001  
Reply to Final Office Action  
Attorney Docket No. 50269-0584

Rather than being necessitated by claim amendments or an IDS, the new grounds of rejection appear to have been necessitated by Parker being determined to be an invalid reference. Therefore, the finality of the rejection is inappropriate.

Applicant requests that the finality of the rejection be removed.

### REJECTIONS BASED ON THE PRIOR ART

#### 35 U.S.C. 102(e)

Claims 1-16 and 24-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Crawford, (U.S. Patent No. 6,781,608). The rejection is traversed for the following reasons.

Currently amended Claim 1 recites, in part:

wherein the selected instant messaging environment affects at least one of:

- a) how said receiving instant messaging application behaves when the instant messaging conversation includes certain content;
- b) the appearance of the history window on said receiving instant messaging application; and
- c) a definition of a user interface command processed by said receiving instant messaging application;

Crawford does not teach or suggest an instant messaging environment that affects any of the following:

- a) how said receiving instant messaging application behaves when the instant messaging conversation includes certain content;
- b) the appearance of the history window on said receiving instant messaging application; and

Application of Christopher Tzann-en Szeto, Ser. No. 09/930,878, Filed August 15, 2001  
Reply to Final Office Action  
Attorney Docket No. 50269-0584

c) a definition of a user interface command processed by said receiving instant messaging application.

Therefore, Claim 1 is patentable over Crawford.

Crawford's teaching of displaying an image, such as a "buddy icon," does not teach or suggest an instant messaging environment that affects how said receiving instant messaging application behaves when the instant messaging conversation includes certain content, as claimed. Referring to FIG. 11 of Crawford, a buddy icon is displayed in the left corner of the bottom portion an instant messaging window (col. 13, lines 18-20). However, there is nothing about displaying the buddy icon in the lower left of the messaging window that is dependent on content in the instant messaging conversation, as claimed. That is, the buddy icon is displayed independent of content in the conversation. Even if, for the sake of argument, the buddy icon were to be considered an instant message environment, it does not affect how said receiving instant messaging application behaves when the instant messaging conversation includes certain content, as claimed.

Crawford's teaching of displaying an image, such as a "buddy icon" that is sent to a receiving computer system does not teach an instant messaging environment that affects the appearance of the history window on said receiving instant messaging application, as claimed. For example, in Fig. 11 Crawford teaches that the buddy icon is displayed in the left corner of the bottom portion an instant messaging window. However, the bottom portion of the messaging window, where the buddy icon is displayed, is not a history window, as claimed. A history window contains messages that were exchanged in the past (specification page 1, lines 14-15). There is nothing in the bottom portion of Crawford's messaging

YHOOP001

18

Application of Christopher Tzann-en Szeto, Ser. No. 09/930,878, Filed August 15, 2001  
Reply to Final Office Action  
Attorney Docket No. 50269-0584

window for messages that were exchanged in the past. It is applicants understanding that Crawford's history window is the region containing the text, "co-worker: Cool Icon, huh?" Therefore, these claim limitations are neither taught nor suggested by this portion of Crawford.

Crawford's teaching of displaying an image, such as a "buddy icon" does not affect a definition of a user interface command processed by said receiving instant messaging application, as claimed. There is simply nothing in displaying the buddy icon that affects a definition of a user interface command, as claimed. Therefore, these claim limitations are neither taught nor suggested by this portion of Crawford.

Crawford's teaching of a "knock-knock dialogue box" in FIG. 10A-10D and at col. 17, lines 18-31 does not teach or suggest an instant messaging environment that affects how said receiving instant messaging application behaves when the instant messaging conversation includes certain content, as claimed. The knock-knock dialogue box does not contain content of the instant messaging conversation. In other words, the knock-knock dialog box does not contain a conversation. The conversation is presented in a specific region of the instant message dialog box (FIG. 11). The knock-knock dialogue box is a separate box from the instant message dialog box (FIG. 11). Because the knock-knock dialogue box does not pertain to content of the instant messaging conversation it does not affect how said receiving instant messaging application behaves when the instant messaging conversation includes certain content, as claimed.

Crawford's teaching of a "knock-knock dialogue box" does not teach or suggest affecting the appearance of the history window on said receiving instant messaging

YHOOP001

19

Application of Christopher Tzann-en Szeto, Ser. No. 09/930,878, Filed August 15, 2001  
Reply to Final Office Action  
Attorney Docket No. 50269-0584

application, as claimed. The knock-knock dialogue box does not contain a history window in that it does not contain messages that were exchanged in the past. The knock-knock dialogue box (FIGs. 10A-10D) contains an alert to the user that a buddy icon is available, along with instructions as to how to view the buddy icon. But there is no history window in the knock-knock dialogue box. Therefore, any change in appearance to the knock-knock dialog box does not affect the appearance of the history window on said receiving instant messaging application, as claimed.

Crawford's teaching of a "knock-knock dialogue box" does not teach or suggest an instant messaging environment that affects a definition of a user interface command processed by said receiving instant messaging application, as claimed. There may be user interface commands associated with the knock-knock dialogue box. However, there is no teaching or suggestion of an instant messaging environment affecting a definition of a user interface command processed by said receiving instant messaging application, as claimed.

Crawford's teaching of gradually increasing the resolution of the displayed buddy icon does not teach or suggest an instant messaging environment that affects how said receiving instant messaging application behaves when the instant messaging conversation includes certain content, as claimed. The gradual increasing of the resolution is based on a user clicking a button to sharpen the image of the buddy icon (FIG. 10A - 10D). However, the process of increasing the resolution is not dependent upon content in the instant messaging conversation. Therefore, these claim limitations are not taught by this portion of Crawford.

YHOOP001

20

Application of Christopher Tzann-en Szeto, Ser. No. 09/930,878, Filed August 15, 2001  
Reply to Final Office Action  
Attorney Docket No. 50269-0584

Crawford's teaching of gradually increasing the resolution of the displayed buddy icon does not teach or suggest an instant messaging environment the appearance of the history window on said receiving instant messaging application, as claimed. As previously discussed, the buddy icon is not located in a history window. Rather, the buddy icon is displayed in a region other than a history window. Therefore, gradually increasing the resolution of the buddy icon displayed does not teach or suggest affecting the appearance of the history window, as claimed.

Crawford's teaching of gradually increasing the resolution of the displayed buddy icon does not teach or suggest an instant messaging environment affecting a definition of a user interface command processed by said receiving instant messaging application, as claimed. As previously discussed, there may be user interface commands associated with the knock-knock dialogue box. However, there is no teaching or suggestion of an instant messaging environment affecting a definition of a user interface command processed by said receiving instant messaging application, as claimed.

Crawford's teaching of allowing a user to set transfer preferences does not teach or suggest affecting how said receiving instant messaging application behaves when the instant messaging conversation includes certain content, as claimed. The transfer preferences govern factors such as which screen names and subscribers can send buddy icons to the client (col. 14, lines 32-34). However, the transfer preferences are not based on content of the instant messaging conversation. FIG. 8 of Crawford shows a GUI for setting preferences. However, there is nothing in Fig. 8 that teaches or suggests affecting how said receiving instant

YHOOP001

21

Application of Christopher Tzann-en Szeto, Ser. No. 09/930,878, Filed August 15, 2001  
Reply to Final Office Action  
Attorney Docket No. 50269-0584

messaging application behaves when the instant messaging conversation includes certain content, as claimed.

The transfer preferences do not teach or suggest an instant messaging environment the appearance of the history window on said receiving instant messaging application, as claimed. Rather, the transfer preferences affect what can be transferred between clients. Referring to Fig. 8, there is nothing that teaches or suggests affecting the appearance of a history window, as claimed.

The transfer preferences do not teach or suggest an instant messaging environment affecting a definition of a user interface command processed by said receiving instant messaging application, as claimed, as claimed. Crawford teaches that the user may be presented a user interface that allows selection of buddy icons and preferences (col. 13, lines 47-51); however, Crawford does not teach that a user interface command is redefined, as claimed. Rather, Crawford's user interface is simply used to receive user input. There is no redefinition of a user interface command, as claimed. Referring to Fig. 8, there is nothing that teaches or suggests redefinition of a user interface command, as claimed. There may be user interface commands associated with the preferences that can be set with the box of FIG. 8. However, there is no teaching or suggestion of an instant messaging environment affecting a definition of a user interface command processed by said receiving instant messaging application, as claimed.

For the foregoing reasons, Claim 1 is patentable over Crawford.

YHOOP001

22

Application of Christopher Tzann-en Szeto, Ser. No. 09/930,878, Filed August 15, 2001  
Reply to Final Office Action  
Attorney Docket No. 50269-0584

Independent Claims 24-31 contain similar limitations as those discussed in the response to Claim 1. Therefore, Claims 24-31 are believed to be allowable. Dependent Claims 2-16 are allowable by virtue of their dependence on Claim 1.

#### NEW CLAIMS

Claims 34-36 have been added. Claims 34-36 are allowable at least by virtue of their dependence from Claim 1.

#### CONCLUSION

The Applicant believes that all issues raised in the Final Office Action have been addressed and that allowance of the pending claims is appropriate.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

YHOOP001

23

Application of Christopher Tzann-en Szeto, Ser. No. 09/930,878, Filed August 15, 2001  
Reply to Final Office Action  
Attorney Docket No. 50269-0584

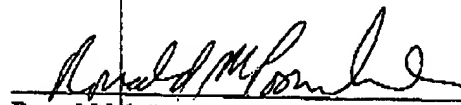
To the extent necessary to make this reply timely filed, the Applicant petitions for an extension of time under 37 C.F.R. § 1.136.

If any applicable fee is missing or insufficient, throughout the pendency of this application, the Commissioner is hereby authorized to any applicable fees and to credit any overpayments to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date: February 14, 2006

  
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Ronald M. Pomerence  
Reg. No. 43,009

2055 Gateway Place, #550  
San Jose, CA 95110  
Telephone: (408) 414-1080, ext. 210  
Facsimile: (408) 414-1076

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on February 14, 2006

by

  
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24

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